

DOCKET NO. 0054.1088-015#14  
KAY  
9-16-02**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

In re Application of: Barbara A. Gilchrest, Mina Yaar and Mark Eller  
Application No.: 09/540,843  
Filed: March 31, 2000  
For: Use of Locally Applied DNA Fragments

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SEP 12 2002

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The owner, Trustees of Boston University, of one hundred percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,955,059. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The terminal disclaimer fee under 37 CFR 1.20(d) is enclosed.

The undersigned is an attorney of record.

September 6, 2002  
Date

Carol A. Egner  
Carol A. Egner  
Registration No. 38,866  
Telephone: (978) 341-0036  
Facsimile: (978) 341-0136

09/11/2002 HHARZI1 00000088 09540843

02 FC:148 110.00-0P

Adjustment date: 01/30/2003 KZEHDI  
09/11/2002 HHARZI1 00000088 09540843  
02 FC:148 -110.00 0P

01/30/2003 KZEHDI 00000003 09540843

03 FC:2814 55.00 0P

## CORRECTION OF PATENTS

1490

## T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 7/16/02  
 TO: EXAMINER Whiteman B APPL. S.N.: 09/540843  
 FROM: KAY PINKNEY ART UNIT: 1635  
PATENT ANALYST  
 SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 9-10-02

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶14.24):
- ☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶14.27.01)
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney "of record" (see ¶¶14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶14.28),
    - ☐ is not recognized as an officer of the assignee (see ¶¶14.29 & possibly 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶14.30).
  - ☐ The T.D. is not signed (see ¶¶14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶14.26, 14.26.04 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶¶14.26, 14.27.02 or 14.27.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

RETURN THIS MEMO TO

KAY PINKNEY  
PATENT ANALYST

(Rev. 5/98)